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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,594	02/18/2004	Thomas Francis Doyle	020122	6306
23696	7590	03/20/2008		
QUALCOMM INCORPORATED 5775 MOREHOUSE DR. SAN DIEGO, CA 92121			EXAMINER NGUYEN, TUAN HOANG	
			ART UNIT 2618	PAPER NUMBER
			NOTIFICATION DATE 03/20/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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kascanla@qualcomm.com

nanm@qualcomm.com

Office Action Summary

Application No.

10/782,594

Applicant(s)

DOYLE ET AL.

Examiner

TUAN H. NGUYEN

Art Unit

2618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see applicant's remarks, filed on 11/14/2007, with respect to the rejection(s) of claims 1-45 under 35 U.S.C § 102(e) and 35 U.S.C § 103(a) have been fully considered. The Applicant filed the DECLARATION UNDER 37 C.F.R. 1.132 on 12/14/2007. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Carpentier et al. (U.S. PUB. 2005/0283613 hereinafter, "Carpentier").

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 5, 10, 13, 17, 21, 26, 28-29, 32, 34-35, 38, and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Carpentier et al. (U.S. PUB. 2005/0283613 hereinafter, "Carpentier").

Consider claims 1, 17 and 38, Carpentier teaches making an asset apparent to an individual, comprising: a receiver for receiving a request directly from a wireless communication device (page 1, [0012]) for having the asset make itself apparent and providing the request to a processor (page 5 [0050]); the processor for receiving the request, for determining how to make the asset apparent (page 5 [0050]); and for generating a command to make the asset apparent (page 5 [0050]); and an interface for providing the command to a device on the asset, the device for making the asset apparent to the individual (page 5 [0049]).

Consider claims 5, 21, and 40, Carpentier teaches processor generates a list of available appetency actions in response to receiving request and further comprises a transmitter for transmitting the list of available appetency actions to a remote entity actions (page 5 [0050]); wherein receiver receives a second request for making asset apparent, second request comprising a selected appetency action from list of available appetency actions (page 4 [0045]).

Consider claim 10, Carpentier teaches wireless communication device for making an asset apparent to an individual, comprising: an input for allowing the individual to enter an identification code corresponding to the asset (page 3 [0031]); a processor for receiving the input and generating a request to make the asset apparent, the request including the identification code (page 5 [0050]); and a transmitter for transmitting the request to the asset (page 8 [0079]).

Consider claim 13, 28 and 34, Carpentier further teaches an output for providing a list of available appetency actions that the asset is able to perform to the individual (page 8 [0077]); the input further for allowing the individual to select one of the available appetency actions (page 8 [0077]); wherein the processor is further for generating the request based on the selected one of available appetency actions (page 5 [0050]).

Consider claims 26 and 32, Carpentier teaches signal-bearing medium tangibly embodying a program of machine-readable instructions executable by a digital processing to perform a method for making an asset apparent page 5 [0050], method comprising operations of: receiving an identification code corresponding to asset (page 3 [0031]); generating a request to make asset apparent (page 3 [0031]); and transmitting request to asset corresponding to identification code over a wireless communication network (page 8 [0079]).

Consider claims 29 and 35, Carpentier further teaches a receiver for receiving the list of available appetency actions from a remote entity (page 5 [0050]).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-4, 6-9, 11-12, 13-14, 18-20, 22-23, 28, 34, 39, and 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carpentier in view of Keillor et al. (US PAT. 5,917,433 hereinafter, "Keillor").

Consider claims 2 and 18, Carpentier teaches making as asset apparent. An individual wishing to locate an asset using an identification code corresponding to the asset.

Carpentier does not explicitly show that the device comprises illumination circuitry.

In the same field of endeavor, Keillor teaches the device comprises illumination circuitry (col. 7 lines 55-65).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use, the device comprises illumination circuitry, as

taught by Keillor, in order to provide an asset monitoring system and associated method for tracking a container so as to identify the location of the container even after the container has been electrically untethered from an external power source.

Consider claims 3 and 19, Keillor further teaches the device comprises audio control circuitry (col. 7 lines 55-65).

Consider claims 4, 20 and 39, Keillor further teaches request comprises a selected appetency action and processor generates command based on selected appetency action (col. 10 lines 47-64).

Consider claims 6, 22, and 42, Keillor further teaches a timer for providing an elapsed time to processor for determining whether the asset was located prior to expiration of a predetermined amount of time for locating the asset (col. 3 lines 45-54).

Consider claims 7, 23 and 43, Keillor further teaches processor generates a message indicative of whether the asset was located prior to expiration of the predetermined amount of time (col. 13 lines 1-25), wherein apparatus further comprises a transmitter for transmitting the message to a remote entity (col. 13 lines 26-35).

Consider claims 8, 24 and 44, Keillor further teaches a timer for determining the current time of day and providing the current time of day to the processor for using the

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current time of day for determining a way in which to make the asset apparent (col. 11 lines 39-48).

Consider claims 9, 25 and 45, Keillor further teaches a position sensor for determining a location of the asset (col. 1 line 58 through col. 2 line2); wherein request comprises a location of an individual requesting that the asset make itself apparent (col. 4 lines 23-32), and processor is further for using the location of the asset and the location of the individual for determining a way in which to make the asset apparent (col. 15 lines 40-50).

Consider claim 11, Keillor further teaches transmitter comprises a cellular transmitter (col. 9 lines 15-33).

Consider claim 12, Keillor further teaches the input is further for receiving a selected method of asset appetency and wherein the request further comprises the selected method (col. 10 lines 47-64).

Consider claim 14, Carpentier further teaches a receiver for receiving the list of available appetency actions from a remote entity (page 5 [0060]).

Consider claim 15, Keillor further teaches a position detector for determining a current location of the wireless communication device (col. 3 lines 36-44); wherein the

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request further comprises the current location of the wireless device for use in determining an appetency action (col. 1 line 58 through col. 2 line 2).

Consider claim 16, Keillor further teaches a timer for determining the current time of day (col. 11 lines 39-48); wherein the request further comprises the current time of day for use in determining an appetency action (col. 11 lines 39-48).

Consider claims 27 and 33, Keillor further teaches operations of: receiving a selected appetency method from a requesting individual (col. 10 lines 47-64); wherein the operation of generating a request to make asset apparent comprises the operation of including selected appetency method along with request (col. 10 lines 47-64).

Consider claims 30 and 36, Keillor further teaches operations of: determining a current location of the signal-bearing medium (col. 3 lines 36-44); wherein the operation of generating a request to make said asset apparent comprises the operation of including said current location of the signal-bearing medium for use in determining an appetency action (col. 1 line 58 through col. 2 line 2).

Consider claims 31 and 37, Keillor further teaches operations of: determining the current time of day (col. 11 lines 39-48); wherein the operation of generating a request to make said asset apparent comprises the operation of including said time of day for use in determining an appetency action (col. 11 lines 39-48).

Consider claim 41, Keillor further teaches determining an elapsed time since the request was received (col. 3 lines 45-54); determining whether the asset was located prior to expiration of a predetermined amount of time (col. 3 lines 45-54).

Conclusion

6. Any response to this action should be mailed to:

Mail Stop_____ (Explanation, e.g., Amendment or After-final, etc.)

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Facsimile responses should be faxed to:

(571) 273-8300

Hand-delivered responses should be brought to:

Customer Service Window

Randolph Building

401 Dulany Street

Alexandria, VA 22313

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan H. Nguyen whose telephone number is (571)272-8329. The examiner can normally be reached on 8:00Am - 5:00Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Maung Nay A. can be reached on (571)272-7882882. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information Consider the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tuan Nguyen
Examiner
Art Unit 2618

/Nay A. Maung/
Supervisory Patent Examiner, Art
Unit 2618